

REMARKS **BEST AVAILABLE COPY**

In this Amendment, Applicant has cancelled Claim 3, Claims 22 – 32 and 41 – 43, without prejudice or disclaimer, has amended Claims 1, 2, 6, 9, 11, 33 – 34 and 36 – 39, and has added new Claims 44 – 45. Claims 1, 6, 9, 11, 33, 36 and 39 have been amended to correct the informality objections thereto. Claims 1, 33, 34 and 39 has been amended to further specify the present invention and overcome the rejections thereto. In addition, Claims 2, 37 – 38 has been amended to proper dependent form. The newly added Claims 44 – 45 have supports in the specification (page 12, lines 11 – 17). It is respectfully submitted that no new matter has been introduced by the amended claims. All claims are now present for examination and favourable reconsideration is respectfully requested in view of the preceding amendments and the following comments.

CLAIM INFORMALITY OBJECTIONS

Claims 1, 3, 6, 9, 11, 33, 36 and 39 have been objected by the Examiner as using redundant phrases and improper Markush languages. By this amendment, Claims 1 and 33 have been deleted the redundant phrases “as herein defined” and used the proper Markush group languages. Claim 3 has been cancelled. Claims 6, 9, 11, 36 and 39 have been amended to use the proper Markush group languages. Therefore, the informalities in these claims have been corrected.

REJECTION UNDER 35 U.S.C. § 102(b)

Claims 1 – 4, 6 – 15, 17 – 19, 21 and 33 – 40 have been rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by the UK Patent Application GB 2 097 024 A, hereinafter UK ‘024. It is respectfully submitted that UK ‘024 does not disclose “a total chloride concentration within the range of from 30 to 1500 mg/litre” and “the accelerator additive being selected from the group of elements consisting of Cu, Ag, Sn, Pb, Sb, Bi, Se

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and Te," which are required by the presently amended Claim 1. In addition, Claim 33 is now restricted to a minimum rare earth element concentration of 125 g/litre. This concentration range is above the highest concentration of cerium in any of the concentrate solutions disclosed in UK '024. In addition, Claim 39 has been limited to an accelerator selected from the group of metals Cu, Ag, Sn, Pb, Sb, Bi, Se and Te. Given that none of these metals are present in any solutions or concentrates disclosed in UK '024, Applicant respectfully submits that claims 39 and 40 are different from the disclosure of UK '024.

Claims 1 – 21 have been rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by the International Application WO 96/15292 A1, hereinafter WO '292. It is respectfully submitted that WO '292 does not disclose the requirements of Claim 1 as presently claimed, which limits a total chloride concentration within the range of from 30 to 1500 mg/litre. This concentration range confers the advantage of minimising corrosion of stainless steel containers holding the solution. As discussed on page 2 of the specification, it is important that new conversion coating solutions be compatible with existing coating apparatus and equipment, which typically include stainless steel containers. Applicant respectfully submits that by controlling the chloride concentration to within 30 to 1500 mg/litre, corrosion of stainless steel equipment is substantially prevented. This claimed range is significantly less than the minimum chloride concentration disclosed in WO '292 namely 3.77 grams/litre, or 3770 mg/litre, which is based upon the stated concentration of cerium chloride in the Examples, namely 13.2 grams per litre (page 11, lines 11 to 13). Therefore, defendant Claims 2 to 21 are also distinguished from WO '292 by virtue of their dependency on Claim 1.

Accordingly, the rejection under 35 U.S.C. § 102(b) has been overcome and withdrawal of the rejection under 35 U.S.C. § 102 (b) is respectfully requested.

## REJECTION UNDER 35 U.S.C. § 103

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Claims 33 – 40 have been rejected under 35 U.S.C. § 103, as allegedly being unpatentable over WO '292 in view of UK '024. It is respectfully submitted that WO '292 does not disclose the required minimum concentration of total rare earth element of 125 g/litre, which is now present in Claims 33 – 38 and 40. The maximum concentration of rare earth ion disclosed in WO '292 is only 50 grams/litre (see page 6). Moreover, the molar ratio of the sum of the accelerator additives to anions in WO '292 does not fall within the range as presently claimed in Claim 39. Thus, one skilled in the art would not discern the present concentrate in Claims 33 to 40 merely by applying the use of concentrates, as taught in UK '024, to the solution compositions taught in WO '292. In addition, there is nothing in WO '292 which would suggest the desirability of preparing concentrates. Even if WO '292 and UK '024 are combined, there is nothing to suggest which particular components of the coating solution should be present in the concentrate, nor the absolute concentrations and/or relative proportions of those components. It is respectfully submitted that Claims 33 to 40 are not obvious in light of WO '292 and UK '024.

## DOUBLE PATENTING

Claims 1 – 21 and 34 – 40 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting, allegedly as being unpatentable over Claims 1 – 21 and 33 – 40 of the co-pending Application No. 09/988,578. It is respectfully submitted that this Application is patentably distinct from the co-pending Application No. 09/988,578. For example, Claim 1 of the present application requires an accelerator be selected from Cu, Ag, Sn, Pb, Sb, Bi, Se or Te, which is not specified and different in scope from Claim 1 of the co-pending Application No. 09/988,578. In addition, Claim 1 of the present application specifically requires a peroxidic species and requires that the solution contains no more than 20 mg/litre each of fluoride and of phosphate, which are not required in Claim 1 of the co-pending Application No. 09/988,578. On the other hand, the “provisional” double patenting rejection should not continue to be made if the “provisional” double patenting rejection is the only rejection in

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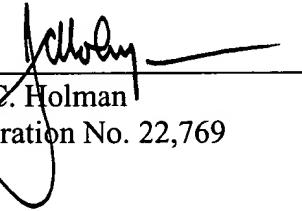
one of the applications. MPEP § 804.I.B.. Accordingly, withdrawal of the rejection of obviousness-type double patenting is respectfully requested.

Having overcome all outstanding grounds of rejection, the application is now in condition for allowance, and prompt action toward that end is respectfully solicited.

Respectfully submitted,

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